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EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

05/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/802,844

Applicant(s)

OHTA, TADASHI

Examiner

AKIBA K. ROBINSON BOYCE

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Due to communications filed 2/11/08, the following is a final office action. Claims 1 and 38 have been amended. Claims 12-37, and 39-40 have been cancelled. Claims 1-11 and 38 are pending in this application and have been examined on the merits. The previous rejection has been adjusted to reflect claim amendments.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (US 6,154,295), in view of Nardozzi et al (US 6,636,837).

As per Claim 1 , Fredlund et al discloses a print service comprising:

A digital image data receiver that directly receives the digital image data from a source of the digital image data via a wired or wireless communication line, (Col. 2, lines 29-30, shows scanning of the visible images to create a digital image file, also as shown in Fig 4, where the computer represents the digital image data receiver,

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and the scanner is the source, where the scanner is connected to the computer via wired communication);

a recorder (26, computer) that records reception date of an order from the user and data identifying the user (col. 3, lines 28-39);

a receiver that receives a present print order from a user, (col. 2, lines 35-38, ordering photographic prints for the customer's home to the photofinisher);

a checker that checks whether or not the reception date of the present print order is within a predetermined period of a reception date of a previous order from the same user in a record recorded in the recorder, (col. 3, lines 41 -57); and

a charge determiner that determines a print charge of the present print order...if the checker finds in the record the previous order from the same user within the predetermined time period, (col. 3, lines 41-57),

wherein a plurality of predetermined periods are prepared in advance in the checker (col. 4, lines 24-55),

and the charge determiner deducts different predetermined amounts set in advance from the print charge based on each of the plurality of predetermined time periods, (col. 3, lines 28-57, and line 4, lines 39-55),

Fredlund et al does not disclose the system that provides a discount to the repeating customer regardless of a content of the previous order by deducting a predetermined amount from the print charge regardless of a content of the pervious order.

However, Nardozzi et al. teaches, for a method and system for ordering photofinishing goods and services. This invention provides an incentive (or promotional discount) to the customer who previously used or ordered before regardless of a content of the previous order (col. 9, lines 18-52).

Since Nardozzi et al. and Fredlund et al. are both from the same field of endeavor of providing an incentive to the customer who previously used or ordered the service, the purpose disclosed by Nardozzi et al. would have been well recognized in the pertinent field of Fredlund et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Fredlund et al. such that the invention provides a discount by deducting a predetermined amount from the print charge to the repeating customer who previously used or ordered regardless of a content of the previous order, as taught by Nardozzi et al, for the purpose of encouraging the customer to keep using and ordering the services in the future.

As per Claim 2, the modified system of Fredlund et al further discloses:

wherein the predetermined period is less than one month (col. 3, lines 50-51).

As per Claim 3, the modified system of Fredlund et al further discloses:

wherein the checker includes a comparator that compares the user of the order of this time with the data identifying the user in the record (see the database and computer in Fig. 1 of Fredlund et al. to process the data to identify the user).

As per Claim 4, the modified system of Fredlund et al further discloses:

wherein the checker includes a comparator that finds out a relationship between the data of the order and the reception data in the record in view of the predetermined period, (Fig. 1 and col . 3, lines 41-57, col. 6, lines 21-35).

As per Claim 5, the modified system of Fredlund et al further discloses:

wherein the comparator includes an adder that adds the predetermined period to the reception date in the record to compare it with the date of the order of this time (col. 4, lines 39-55).

As per Claim 6, the modified system of Fredlund et al further discloses:

wherein the comparator includes a subtractor that subtracts the predetermined period from the date of the order of this time to compare it with the reception date in the record, , (col. 3, lines 41-57).

As per Claim 7, the modified system of Fredlund et al further discloses:

wherein the comparator includes a finder that finds a period between the date of the order of this time and the reception date in the record to compare it with the predetermined period (col. 3, lines 28-57, and line 4, lines 39-55).

As per Claim 8, the modified system of Fredlund et al further discloses:

wherein the checker checks up if the user used the same print service within the predetermined period, (col. 3, lines 41 -57).

As per Claim 9, the modified system of Fredlund et al further discloses:

the print service further comprising a reception that receives the order, wherein the checker checks up if the order is through the same reception within the predetermined period (col. 3, lines 28-57, and line 4, lines 39-55).

As per Claim 10, the modified system of Fredlund et al further discloses:
wherein the contents to be recorded by the recorder are attached to the digital image data, (col. 4, lines 24-38).

As per Claim 11 , the modified system of Fredlund et al further discloses:
wherein the contents to be recorded by the recorder are embedded in the digital image data (col. 3, lines 28-39).

As per Claim 38, the modified system of Fredlund et al further discloses:
a digital image data receiver that directly receives the digital image data from a source of the digital image data via a wired or wireless communication line, (Col. 2, lines 29-30, shows scanning of the visible images to create a digital image file, also as shown in Fig 4, where the computer represents the digital image data receiver, and the scanner is the source, where the scanner is connected to the computer via wired communication);

a recorder, (26, computer) that records a reception date of orders received from users and data identifying each user, (col. 3, lines 28-39);

a receiver that receives a present print order from a user, (col. 2, lines 35-38, ordering photographic prints for the customer's home to the photofinisher); and

a charge determiner that determines a print charge of the present print order by deducting a predetermined amount..., based upon a record recorded in the recorder, that the reception date of the present print order is within a predetermined time period of a reception date of a previous order from the same user, (col. 3, lines 41-57),

wherein a plurality of predetermined periods are prepared in advance, (col. 4, lines 24-55),

and the charge determiner deducts different predetermined amounts set in advance to be deducted from the print charge based on each of the plurality of predetermined time periods, (col. 3, lines 28-57, and line 4, lines 39-55),

Fredlund et al does not disclose the system that makes a determination regardless of a content of the previous order by deducting a predetermined amount from the print charge regardless of a content of the pervious order.

However, Nardozzi et al. teaches, for a method and system for ordering photofinishing goods and services. This invention provides an incentive (or promotional discount) to the customer who previously used or ordered before regardless of a content of the previous order (col. 9, lines 18-52).

Since Nardozzi et al. and Fredlund et al. are both from the same field of endeavor of providing an incentive to the customer who previously used or ordered the service, the purpose disclosed by Nardozzi et al. would have been well recognized in the pertinent field of Fredlund et al.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Fredlund et al. such that the invention makes a charge determination by deducting a predetermined amount from the print charge to the repeating customer who previously used or ordered regardless of a content of the previous order, as taught by Nardozzi et al, for the purpose of encouraging the customer to keep using and ordering the services in the future.

Response to Arguments

4. Applicant's arguments filed 2/11/08 have been fully considered but they are not persuasive.

Applicant argues that the combination of Fredlund and Nardoizzi fails to disclose, or reasonably to have suggested, that a plurality of predetermined time periods are prepared in advance in a checker as recited in independent claim 1 and similarly recited in independent claim 38, and argues that Fredlund discloses that customers can have the digital file of their negatives extended for a certain amount of time (see col. 3, line 50), which appears to be determined by the customer, not a plurality of predetermined time periods prepared in advance by the computer 26. However, in Col. 3, lines 47-52, Fredlund shows that a customer can call a 1-800 number to extend the digital files for a certain period of time. In this case, this is an ordered service, which occurs in advance, since the digital files ordered have not yet been extended, and are pre-determined to be a certain period of time, such as a month. Also, in Fredlund, all ordered services must go through computer 26, since as shown in col. 3, lines 27-31 of Fredlund, the computer 26 stores the digital image file along with a customer order number and a unique customer identification number in a mass storage device. Therefore, as shown in Fredlund, the predetermined time periods, when ordering the extension of digital files are derived or prepared by computer 26 for selection purposes.

In addition, applicant argues that the combination of Fredlund and Nardoizzi fails to disclose a charge determiner deducts different predetermined amounts set in advance from a print charge based on each of the plurality of predetermined time periods, and Fredlund merely teaches that, "During the time period, there are several services that they can order, and special price advantages may be offered" (col. 3, lines 54-56). However, there is no evidence that Fredlund deducts different predetermined amounts set in advance from a print charge based on each of the plurality of predetermined time periods, as recited in independent claims 1 and 38. However, in Fredlund et al, it is during this "time period" that special price advantages are offered, which is analogous to time periods of the present claims where an amount is deducted for a particular time period since in Fredlund, the purpose of storing the digital file is to use it to order a print service within a specified period of time as shown in Col. 4, lines 43-46. Since it is not possible to place a print order without having a print file (print order does not exist without print file), and in Fredlund et al, since if no print service is ordered, the file is then automatically deleted, charging for the print order for that specified time period it is analogous to charging for the print file. In addition, "the special prices that may apply" does not only correspond to only one discount amount. Col. 3, lines 41-44, of Fredlund et al shows that there are specific prices per customer order. Therefore, in Col. 3, lines 51-56, when the customer orders a special service, and special prices apply for a particular time period, each specific special price applies for each special order.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is 571-272-6734. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

•Patent Application Information Retrieval (PAIR) system, Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

A. R. B.
May 7, 2008

/Akiba K Robinson-Boyce/

Primary Examiner, Art Unit 3628